

**Remarks**

This application has been carefully reviewed in light of the Office Action mailed June 7, 2004. Applicants appreciate the Examiner's consideration of the application. Although Applicants believe all pending claims are allowable without amendment, Applicants have made clarifying amendments to Claims 1-7. Certain of these amendments are not considered narrowing or necessary for patentability. Applicants have also added new Claims 8-20, none of which add any new matter. Applicants also respectfully provide these remarks. Applicants respectfully request reconsideration and allowance of all original claims and consideration and allowance of all new claims.

**I. Clarification of Priority Claim in the Declaration**

The Examiner notes that the Declaration includes a statement claiming the benefit of provisional application 60/172,279, filed December 17, 1999, which is inconsistent with the priority claim listed in the Specification. Applicants submit that this is a typographical error on the Declaration. The provisional application to which this Application claims priority is U.S. Provisional Application 60/187,342, filed March 6, 2000, which is correctly listed in the Specification on Page 2. Applicants appreciate the Examiner's calling this typographical error to Applicants' attention.

**II. Objections to the Specification**

The Examiner objects to the Abstract as not adequately discussing the subject matter of the dependent claims and as including an incomprehensible second sentence. The Examiner also objects to the disclosure, stating that the second sentence of the Summary of the Invention section is incomprehensible. (Office Action, Page 2)

With respect to the second sentences of the Summary of the Invention and the Abstract, Applicants have corrected what appears to have been a typographical error in each of these sentences. With respect to the Examiner's objection to the Abstract as not discussing the subject matter of the dependent claims, Applicants do not find any such requirement in the applicable statute and regulations, or in the M.P.E.P. However, in order to advance prosecution in this case, Applicants have amended the Abstract to include a discussion of at least certain of the dependent claims. Given the one hundred fifty-word limit on the Abstract, it would be difficult, if not

impossible, to discuss in the Abstract the subject matter of each of Applicants' dependent claims. None of these amendments should be construed so as to narrow Applicants' claims in any way.

For at least these reasons, Applicants respectfully request that the Examiner withdraw the objections to the Specification.

### **III. The Claims are Allowable under 35 U.S.C. § 103**

#### **A. The Claims are Allowable over the Proposed *Birrell-Kawagoe* Combination**

The Examiner rejects Claims 1-7 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,009,462 to Birrell et al. ("*Birrell*") in view of U.S. Patent 5,961,595 to Kawagoe et al. ("*Kawagoe*") for the reasons stated in the PCT Written Opinion for international application No. PCT/US01/40256. Applicants respectfully disagree.

At the outset, Applicants note that in the Written Opinion, it appears to Applicants that the Examiner who wrote that opinion based the rejection of Claims 1-2 and 5-6 solely on *Birrell* (i.e. as lacking novelty over *Birrell*) and the rejection of Claims 3, 4, and 7 on a proposed *Birrell-Kawagoe* combination (i.e. as lacking an inventive step over the proposed *Birrell-Kawagoe* combination). Thus, because the Examiner of the present Application structured the rejection of each of Claims 1-7 as an obviousness rejection, it is not entirely clear to Applicants what rejection of Claims 1-7 the Examiner intended when referencing the Written Opinion. In any event, Applicants respectfully submit that *Birrell*, whether considered alone or in combination with *Kawagoe*, fails to disclose, teach, or suggest various limitations recited in Claims 1-7, and that the Examiner has not provided the required teaching, suggestion, or motivation to modify or combine these references. Applicants discuss Claim 1 as an example.

#### **1. The Proposed *Birrell-Kawagoe* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Claim 1, as Amended**

Independent Claim 1, as amended, recites:

A computer-implemented messaging system for facilitating distributed processing by reliably handling messages communicated between a sending process and one or more receiving processes, comprising:  
a message collector operable to receive a message from a sending

process that is operable to generate and send the message, the message specifying a receiving process as an intended destination of the message generated by the sending process; and

a local queue manager operable to:

receive the message from the message collector;

queue the message received from the message collector in a queue for communication to the receiving process that is the intended destination of the message; and

store the message in a persistent storage device in communication with the local queue manager, the persistent storage device operable to reliably store the message until the message is removed by the receiving process after the message is received by the receiving process for processing;

the message received from the sending process being stored at the persistent storage device until the receiving process removes the message from the persistent storage device after the message is received by the receiving process for processing, storing the message at the persistent storage device until the message is removed by the receiving process after being received by the receiving process enhancing reliability that the message will be successfully communicated to the receiving process.

In contrast, *Birrell* merely discloses a computer-implemented method for downloading mail messages in a distributed computer system. (Column 1, Lines 64-65) The distributed mail service system includes a plurality of client computers connected to a mail service system via a network. (Column 1, Lines 65-67) Mail messages are stored in message files of the mail service system. (Column 2, Lines 1-2) A particular mail message includes a primary component encoded in a first format and at least one secondary component encoded in a second format different than the first component. (Column 2, Lines 2-5) According to *Birrell*, the secondary component can be embedded "unenconded" enclosures, embedded base 64 enclosures, embedded post-script documents, embedded HTML pages, or embedded MIME fragments. (Column 2, Lines 11-14) The particular message is requested by a particular one of a plurality of client computer systems. (Column 2, Lines 6-7) The secondary component is replaced by a hot-link, and the primary component and the hot-link are sent to the particular client computer. (Column 2, Lines 7-10) The secondary component is sent to the particular client computer when a user of the particular client computer clicks on the hot-link. (Column 2, Lines 15-17)

Applicants note that *Birrell* appears to be limited to the handling of email messages. In contrast to Claim 1, *Birrell* has nothing to do with distributed processing, distributed processes, or handling messages communicated between distributed processes in a distributed computing

environment. Thus, *Birrell* is not even directed to a “computer-implemented messaging system for facilitating distributed processing by reliably handling messages communicated between a sending process and one or more receiving processes,” as recited in Claim 1, as amended. Similarly, *Birrell* fails to disclose, teach, or suggest “a sending *process*” and “a receiving *process*” sending and receiving a message, respectively, as recited in Claim 1. *Kawagoe* fails to make up for this deficiency of *Birrell*. Claim 1 is allowable for at least this reason.

Additionally, *Birrell* fails to disclose, teach, or suggest at least the following limitations recited in Claim 1, as amended:

- a local queue manager operable to:
  - receive the message from the message collector;
  - queue the message received from the message collector in a queue for communication to the receiving process that is the intended destination of the message; and
  - store the message in a persistent storage device in communication with the local queue manager, the persistent storage device operable to reliably store the message until the message is removed by the receiving process after the message is received by the receiving process for processing; and
- the message received from the sending process being stored at the persistent storage device until the receiving process removes the message from the persistent storage device after the message is received by the receiving process for processing, storing the message at the persistent storage device until the message is removed by the receiving process after being received by the receiving process enhancing reliability that the message will be successfully communicated to the receiving process.

For example, *Birrell* fails to disclose, teach, or suggest “a local queue manager operable to . . . receive the message from the message collector,” “queue the message received from the message collector in a queue for communication to the receiving process that is the intended destination of the message,” and “store the message in a persistent storage device operable to reliably store the message until the message is removed by the receiving process after the message is received by the receiving process for processing,” as recited in Claim 1 as amended. The portion of *Birrell* cited in the Written Opinion as disclosing the local queue manager (as recited in Claim 1 prior to the amendments presented in this Response) fails to even mention a queue, let alone a local queue manager. Even more clearly, *Birrell* fails to disclose, teach, or suggest the functionality of the local queue manager recited in Claim 1, as amended. *Kawagoe* fails to make up for this deficiency of *Birrell*.

As another example, *Birrell* fails to disclose, teach, or suggest “the message received from the sending process being stored at the persistent storage device until the receiving process removes the message from the persistent storage device after the message is received by the receiving process for processing, storing the message at the persistent storage device until the message is removed by the receiving process after being received by the receiving process enhancing reliability that the message will be successfully communicated to the receiving process,” as recited in Claim 1 as amended. *Kawagoe* fails to make up for this deficiency of *Birrell*. *Birrell* does not appear to disclose, teach, or suggest storing the email messages disclosed in *Birrell* (which the Examiner apparently equates with the message recited in Claim 1) “until the receiving process removes the message from the persistent storage device after the message is received by the receiving process for processing,” as recited in Claim 1 as amended. Moreover, *Birrell* also fails to disclose, teach, or suggest “storing the message at the persistent storage device until the message is removed by the receiving process after being received by the receiving process enhancing reliability that the message will be successfully communicated to the receiving process,” as recited in Claim 1 as amended. *Kawagoe* fails to make up for these deficiencies of *Birrell*.

## **2. The Proposed *Birrell-Kawagoe* Combination is Improper**

The rejection of Applicants' claims is also improper because the Examiner has not shown the required teaching, suggestion, or motivation in *Birrell*, *Kawagoe*, or knowledge generally available to those of ordinary skill in the art at the time of the invention to modify or combine *Birrell* or *Kawagoe* in the manner the Examiner proposes. The rejected claims are allowable for at least this reason.

Applicants respectfully submit that the Examiner's assertion that it would have been obvious to combine the teachings of *Birrell* with the teachings of *Kawagoe* to arrive at Applicants' invention is insufficient to support a *prima facie* case of obviousness under 35 U.S.C. § 103(a) under the M.P.E.P. and the governing Federal Circuit case law.

The question raised under 35 U.S.C. § 103 is whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art at the time of the

invention. Accordingly, even if all elements of a claim are disclosed in various prior art references, which is certainly not the case here as discussed above, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill at the time of the invention would have been prompted to modify the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention. It is clear based at least on the many distinctions discussed above that the proposed *Birrell-Kawagoe* combination does not, taken as a whole, suggest the claimed invention, taken as a whole.

The M.P.E.P. sets forth the strict legal standard for establishing a *prima facie* case of obviousness based on modification or combination of prior art references. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references where combined) must teach or suggest all the claim limitations." M.P.E.P. § 2142, 2143. The teaching, suggestion, or motivation for the modification or combination and the reasonable expectation of success must both be found in the prior art and cannot be based on an applicant's disclosure. *See Id.* (citations omitted). "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art" at the time of the invention. M.P.E.P. § 2143.01. Even the fact that references *can* be modified or combined does not render the resultant modification or combination obvious unless the prior art teaches or suggests the desirability of the modification or combination. *See Id.* (citations omitted). Moreover, "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. All words in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. § 2143.03 (citations omitted).

The governing Federal Circuit case law makes this strict legal standard even more clear.<sup>1</sup> According to the Federal Circuit, "a showing of a suggestion, teaching, or motivation to combine

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<sup>1</sup> Note M.P.E.P. 2145 X.C. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.").

or modify prior art references is an essential component of an obviousness holding.” *In re Sang-Su Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000)). “Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved.” *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). However, the “range of sources available . . . does not diminish the requirement for actual evidence.” *Id.* Although a prior art device “may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.” *In re Mills*, 916 F.2d at 682, 16 U.S.P.Q.2d at 1432. *See also In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) (holding a *prima facie* case of obviousness not made where the combination of the references taught every element of the claimed invention but did not provide a motivation to combine); *In Re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1944 (Fed. Cir. 1992) (“Conspicuously missing from this record is any evidence, other than the PTO’s speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at” the claimed invention.). Even a determination that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed modification or combination is not sufficient to establish a *prima facie* case of obviousness. *See In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988).

In addition, the M.P.E.P. and the Federal Circuit repeatedly warn against using an applicant's disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, “The tendency to resort to ‘hindsight’ based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.” M.P.E.P. § 2142. The governing Federal Circuit cases are equally clear. “A critical step in analyzing the patentability of claims pursuant to [35 U.S.C. § 103] is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one ‘to fall victim to the insidious effect of a

hindsight syndrome wherein that which only the invention taught is used against its teacher." *In re Kotzab*, 217 F.3d 1365, 1369, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000) (citations omitted). In *In re Kotzab*, the Federal Circuit noted that to prevent the use of hindsight based on the invention to defeat patentability of the invention, the court requires the Examiner to show a sufficient motivation in the prior art to combine the references that allegedly create the case of obviousness. *See id.* *See also, e.g., Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988). Similarly, in *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board, explaining that the required evidence of such a teaching, suggestion, or motivation is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999, 50 U.S.P.Q.2d at 1617 (emphasis added) (citations omitted).

With respect to the proposed *Birrell-Kawagoe* combination, the Written Opinion states, "It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Birrell et al.* and *Kawagoe et al.* because *Kawagoe et al.*'s message converter would provide for a message having a common format, thereby multiple new message types can be added to the system without impacting the message handling performed on the messages." (Written Opinion, Section V.2) Whether or not this is true, this proposed motivation to combine would have no bearing on Claim 1. As discussed above, the Examiner responsible for the Written Opinion did not use *Kawagoe* as a basis for rejecting Claim 1 (and other claims). The Examiner in the present case has provided no motivation for combining the teachings of *Birrell* with the teachings of *Kawagoe* for purposes of rejecting Claim 1 (and other claims). In any event, this supposed motivation for combining *Birrell* and *Kawagoe* appears to have been taken verbatim from Applicants' Specification, which constitutes impermissible hindsight reconstruction of Applicants' invention and is specifically prohibited by the M.P.E.P. and controlling Federal Circuit case law, as discussed above. In particular, Applicants' Specification recites, "Because the transport system does not care about the type of the underlying message, it



can be used for messages of any type. The message collector 28 formats any type of message into a standard type, and it is returned to its original type in the appropriate plug in selected by the message writer 36. Thus, ***multiple new message types can be added to the system without impacting the message handling performed on the messages.***" (Page 11, Lines 13-18; emphasis added)

Accordingly, since the prior art fails to provide the required teaching, suggestion, or motivation to combine *Birrell* with *Kawagoe* in the manner the Examiner proposes, Applicants respectfully submit that the Examiner's conclusions set forth in the Office Action (via the citation of the Written Opinion) fall well short of the requirements set forth in the M.P.E.P. and the governing Federal Circuit case law for demonstrating a *prima facie* case of obviousness. Thus, Applicants respectfully submit that the Examiner's proposed combination of *Birrell* with *Kawagoe* appears to be merely an attempt, with the benefit of hindsight, to reconstruct Applicants' claims and is unsupported by the teachings of *Birrell* and *Kawagoe*. Applicants respectfully submit that the rejection must therefore be withdrawn.

Second, as demonstrated above, Applicants respectfully submit that *Birrell* is wholly inadequate as a reference against independent Claim 1. Thus, even if *Kawagoe* disclosed the portions of Claim 1 that the Examiner suggests, and even if there was the required teaching, suggestion, or motivation to combine *Birrell* with *Kawagoe* as the Examiner proposes, the proposed *Birrell-Kawagoe* combination would still fail to disclose, teach, or suggest the limitations specifically recited in independent Claim 1, as is required under the M.P.E.P. and the governing Federal Circuit cases for a *prima facie* case of obviousness.

For at least these reasons, Applicants respectfully request reconsideration and allowance of independent Claim 1 and its dependent claims. For substantially similar reasons, Applicants respectfully request reconsideration and allowance of independent Claim 5, new independent Claim 17, and their respective dependent claims.

**B. The Claims are Allowable over the Proposed *Godlewski-Foladare* Combination**

The Examiner rejects Claims 1-7 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,421,354 to Godlewski ("*Godlewski*") in view of U.S. Patent 6,373,926 to Foladare et al. ("*Foladare*"). Applicants respectfully disagree.

**1. The Proposed *Godlewski-Foladare* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Claim 1, as Amended**

*Godlewski* merely discloses a system and method for retrieval of data from remote sensors using multiple communication channels. According to the portion of *Godlewski* on which the Examiner primarily relies, a communicator associated with a sensor sends a message using the most available transport subsystem. (Column 12, Lines 16-17; Column 10, Line 64 through Column 11, Line 4) The transport interface of a network operations center receives the message from the applicable transport subsystem, as an email for example. (Column 12, Lines 18-27) The transport interface of the network operations center extracts the contents of the message and converts them into a common format. (Column 12, Lines 28-30) The formatted message is sent to a message and command handler, which processes the message. The message and command handler applies predetermined criteria to determine whether to store the message and whether to send a message to the applicable customer. For example, in the case of a series of temperature readings, the criteria might consist of storing all readings and notifying the customer of all readings falling outside of a predetermined temperature range. (Column 12, Lines 36-44) If the message and command handler has determines that a message should be stored, the message is stored in memory by the storage module. (Column 12, Lines 59-61) If the message and command handler determines that a message should be sent to the customer, the message is sent to the customer through the appropriate communications medium. (Column 13, Lines 3-4)

However, *Godlewski*, whether considered alone or in combination with *Foladare*, fails to disclose, teach, or suggest various limitations recited in applicants claims. Applicants discuss amended Claim 1 as an example.

Applicants initially note that, in contrast to Claim 1, *Godlewski* has nothing to do with distributed processing, distributed processes, or handling messages communicated between

distributed processes in a distributed computing environment. Thus, *Godlewski* is not even directed to a “computer-implemented messaging system for facilitating distributed processing by reliably handling messages communicated between a sending process and one or more receiving processes,” as recited in Claim 1, as amended. Similarly, *Godlewski* fails to disclose, teach, or suggest “a sending *process*” and “a receiving *process*” sending and receiving a message, respectively, as recited in Claim 1. Claim 1 is allowable for at least this reason.

The Examiner apparently equates the communicator associated with the sensor, as disclosed in *Godlewski*, with the sending process, as recited in Claim 1. The Examiner also apparently equates the receiving process recited in Claim 1 with the customer disclosed in *Godlewski*. Applicants respectfully submit that this equation is improper. Claim 1 specifically recites that the receiving process is a *process*. Furthermore, Claim 1 is directed to a “computer-implemented messaging system for facilitating distributed processing by reliably handling messages communicated between a sending process and one or more receiving processes.” A user is not a process. Claim 1 is allowable for at least this reason.

Additionally, *Godlweski* fails to disclose, teach, or suggest at least the following limitations recited in Claim 1, as amended:

- a local queue manager operable to:
  - receive the message from the message collector;
  - queue the message received from the message collector in a queue for communication to the receiving process that is the intended destination of the message; and
  - store the message in a persistent storage device in communication with the local queue manager, the persistent storage device operable to reliably store the message until the message is removed by the receiving process after the message is received by the receiving process for processing; and
- the message received from the sending process being stored at the persistent storage device until the receiving process removes the message from the persistent storage device after the message is received by the receiving process for processing, storing the message at the persistent storage device until the message is removed by the receiving process after being received by the receiving process enhancing reliability that the message will be successfully communicated to the receiving process.

For example, *Godlewski* fails to disclose, teach, or suggest “a local queue manager operable to . . . receive the message from the message collector,” “queue the message received

from the message collector in a queue for communication to the receiving process that is the intended destination of the message,” and “store the message in a persistent storage device operable to reliably store the message until the message is removed by the receiving process after the message is received by the receiving process for processing,” as recited in Claim 1 as amended. The portion of *Godlewski* cited by the Examiner as disclosing the local queue manager (as recited in Claim 1 prior to the amendments presented in this Response) fails to even mention a queue, let alone a local queue manager. (See Office Action Page 4 and Column 12, Lines 37-41) Instead, the Examiner equates the command handler disclosed in *Godlewski* with the local queue manager recited in Claim 1. However, nowhere does *Godlewski* disclose, teach, or suggest that its command handler is operable to “receive the message from [a] message collector,” “queue the message received from the message collector in a queue for communication to the receiving process that is the intended destination of the message,” and “store the message in a persistent storage device operable to reliably store the message until the message is removed by the receiving process after the message is received by the receiving process for processing,” as recited in Claim 1 as amended.

As another example, *Godlewski* fails to disclose, teach, or suggest “the message received from the sending process being stored at the persistent storage device until the receiving process removes the message from the persistent storage device after the message is received by the receiving process for processing, storing the message at the persistent storage device until the message is removed by the receiving process after being received by the receiving process enhancing reliability that the message will be successfully communicated to the receiving process,” as recited in Claim 1 as amended. Instead, *Godlewski* merely discloses that the message and command handler applies predetermined criteria to determine whether to store the message and whether to send a message to the applicable customer. For example, in the case of a series of temperature readings, the criteria might consist of storing all readings and notifying the customer of all readings falling outside of a predetermined temperature range. (Column 12, Lines 36-44) If the message and command handler has determines that a message should be stored, the message is stored in memory by the storage module. (Column 12, Lines 59-61)

The Examiner appropriately acknowledges that *Godlewski* “does not expressly teach the limitation of storing messages until they are removed” and “wherein the receiving process

removes each message from the persistent storage device after each message is received,” as recited in Claim 1 prior to the amendments presented in this Response. (Office Action, Page 4) Applicants respectfully submit that, in addition to the deficiencies of *Godlewski* discussed above, these acknowledged deficiencies of *Godlweski* remain with respect to Claim 1, as amended.

The Examiner argues that *Foladare* teaches “a centralized messaging system that sends messages from a sending party to the messaging services of the receiving party.” (Office Action, Page 4) The Examiner further argues that *Foladare* “discloses that messages are stored at messaging services until they have been accessed by the receiving party” and that *Foladare* “discloses that messages are deleted from the messaging services after they have been accessed by the receiving party.” (Office Action, Page 4) Applicants respectfully submit that *Foladare* fails to make up for both the demonstrated and acknowledged deficiencies of *Godlewski*.

*Foladare* merely discloses a centralized messaging service method and apparatus in which a message is sent to each of a subscriber's messaging services. (Abstract) According to *Foladare*, when a sending party wishes to leave a message for a receiving party, the sending party activates his/her user device and enters the access number for the centralized message service. (Abstract) The centralized message service receives the communication signals from the sending party, which include a receiving party identifier and the message to be sent. (Abstract) The centralized message service then retrieves profile information from a database corresponding to the messaging services of the receiving party based on the receiving party identifier entered by the sending party. (Abstract) The centralized message service then forwards the message to a portion of the receiving party's messaging services based on the profile information retrieved from the database, and then monitors the messaging services to determine if the receiving party has retrieved the message from any of the messaging services. (Abstract) If the receiving party retrieves the message from any of the messaging services, a delete command is sent to at least a portion of the other messaging services based on the profile information retrieved. (Abstract)

Like *Godlweski* and in contrast to Claim 1, *Foladare* has nothing to do with distributed processing, distributed processes, or handling messages communicated between distributed processes in a distributed computing environment. Instead, *Foladare* is directed to a centralized messaging service method and apparatus in which a message is sent to each of a subscriber's

messaging services. Thus, *Foladare* is not even directed to a “computer-implemented messaging system for facilitating distributed processing by reliably handling messages communicated between a sending process and one or more receiving processes,” as recited in Claim 1, as amended. Similarly, *Foladare* fails to disclose, teach, or suggest “a sending *process*” and “a receiving *process*” sending and receiving a message, respectively, as recited in Claim 1. Claim 1 is allowable for at least this reason.

In addition, *Foladare* fails to disclose, teach, or suggest “the message received from the sending process being stored at the persistent storage device until the receiving process removes the message from the persistent storage device after the message is received by the receiving process for processing, storing the message at the persistent storage device until the message is removed by the receiving process after being received by the receiving process enhancing reliability that the message will be successfully communicated to the receiving process,” as recited in Claim 1 as amended. *Foladare* discloses that if the receiving party retrieves the message from any of the messaging services, a delete command is sent to at least a portion of the other messaging services based on the profile information retrieved. (Abstract and Column 4, Line 63 through Column 5, Line 2) However, assuming for the sake of argument that the messages disclosed in *Foladare* could even be equated with the message recited in Claim 1 (which Applicants do not concede), *Foladare* would still fail to disclose, teach, or suggest that “the message received from the sending process [is] stored at the persistent storage device *until the receiving process removes the message from the persistent storage device after the message is received by the receiving process for processing*,” as recited in Claim 1 as amended.

## **2. The Proposed *Godlewski-Foladare* Combination is Improper**

The rejection of Applicants' claims is also improper because the Examiner has not shown the required teaching, suggestion, or motivation in *Godlewski*, *Foladare*, or knowledge generally available to those of ordinary skill in the art at the time of the invention to modify or combine *Godlewski* or *Foladare* in the manner the Examiner proposes. The rejected claims are allowable for at least this reason.

Applicants respectfully submit that the Examiner's assertion that it would have been obvious to combine the teachings of *Godlewski* with the teachings of *Foladare* to arrive at

Applicants' invention is insufficient to support a *prima facie* case of obviousness under 35 U.S.C. § 103(a) under the M.P.E.P. and the governing Federal Circuit case law.

Applicants reiterate the standard for proving a *prima facie* case of obviousness that is incumbent on the Examiner. As demonstrated above, Applicants respectfully submit that the proposed combination fails to disclose, teach, or suggest various limitations recited in Claim 1, for example. In addition, Applicants respectfully submit that the Examiner has failed to provide the proper teaching, suggestion, or motivation to combine or modify the cited references in the manner proposed by the Examiner.

With respect to the proposed *Godlewski-Foladare* combination, the Examiner states, "It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Godlewski in view of Foladare so as to delete messages after delivery to the intended recipients. One would have been motivated to do so to save space in the storage device." (Office Action, Page 5) However, there is no disclosure, teach, or suggestion in *Godlewski* that there would be any desire or need to store the message "at the persistent storage device until the receiving process removes the message from the persistent storage device after the message is received by the receiving process for processing, storing the message at the persistent storage device until the message is removed by the receiving process after being received by the receiving process enhancing reliability that the message will be successfully communicated to the receiving process," as recited in Claim 1. Indeed, there is no disclosure, teaching, or suggestion in *Godlewski* that there would be any desire or need to delete messages in the manner disclosed in *Foladare*. Similarly, there is no disclosure, teaching, or suggestion in *Foladare* that it would be desirable to incorporate its technique of deleting messages of the type disclosed in *Foladare* into a sensor notification system such as the one disclosed in *Godlewski*. The deleting that is disclosed in *Foladare* is apparently for purposes of deleting redundant copies of a message left by one subscriber for another subscriber once an instance of the message has been checked by the receiving subscriber. There does not appear to be any reason to even attempt to incorporate, let alone to actually incorporate, such a deleting technique into the sensor notification system disclosed in *Godlewski*.

Furthermore, Applicants do not concede that *Godlewski* and *Foladare* are analogous art; however, even if *Godlewski* and *Foladare* could be considered analogous art, this determination would not substitute for the requisite teaching, suggestion, or motivation to combine or modify the references that must be shown by the Examiner.

Accordingly, since the prior art fails to provide the required teaching, suggestion, or motivation to combine *Godlewski* with *Foladare* in the manner the Examiner proposes, Applicants respectfully submit that the Examiner's conclusions set forth in the Office Action fall well short of the requirements set forth in the M.P.E.P. and the governing Federal Circuit case law for demonstrating a *prima facie* case of obviousness. Thus, Applicants respectfully submit that the Examiner's proposed combination of *Godlewski* with *Foladare* appears to be merely an attempt, with the benefit of hindsight, to reconstruct Applicants' claims and is unsupported by the teachings of *Godlewski* and *Foladare*. Applicants respectfully submit that the rejection must therefore be withdrawn.

Second, as demonstrated above, Applicants respectfully submit that *Godlewski* is wholly inadequate as a reference against independent Claim 1. Thus, even if *Foladare* disclosed the portions of Claim 1 that the Examiner suggests, and even if there was the required teaching, suggestion, or motivation to combine *Godlewski* with *Foladare* as the Examiner proposes, the proposed *Godlewski-Foladare* combination would still fail to disclose, teach, or suggest the limitations specifically recited in independent Claim 1, as is required under the M.P.E.P. and the governing Federal Circuit cases for a *prima facie* case of obviousness.

For at least these reasons, Applicants respectfully request reconsideration and allowance of independent Claim 1 and its dependent claims. For substantially similar reasons, Applicants respectfully request reconsideration and allowance of independent Claim 5, new independent Claim 17, and their respective dependent claims.

#### **IV. No Waiver**

All of Applicants' arguments and amendments are without prejudice or disclaimer. Additionally, Applicants have merely discussed example distinctions from the references cited by the Examiner. Other distinctions may exist, and Applicants reserve the right to discuss these



additional distinctions in a future Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicants are sufficient to overcome the Examiner's rejections.

**Conclusion**

Applicants have made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicants respectfully request full allowance of all pending claims.

If the Examiner believes a telephone conference would advance prosecution of this case in any way, the Examiner is invited to contact Christopher W. Kennerly, Attorney for Applicants, at the Examiner's convenience at (214) 953-6812.

A fee of \$104.00 is due to cover the cost of one claim total over twenty and one independent claim over three. The Commissioner is hereby authorized to charge the fee of \$104.00 and any other fees or to credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.  
Attorneys for Applicants



Christopher W. Kennerly  
Reg. No. 40,675

Date: September 7, 2004

Correspondence Address:  
Baker Botts L.L.P.  
2001 Ross Avenue, 6th Floor  
Dallas, Texas 75201-2980  
Tel. (214) 953-6812

Customer No.: **05073**